

REMARKS

Reconsideration of the above-identified patent application in view of the proposed amendment above and the remarks below is respectfully requested.

No claims are proposed to be canceled or added in this paper. Claims 1, 7, 9 and 12 are proposed to be amended in this paper. Accordingly, claims 1-12¹ are pending and are under active consideration.

Claims 1-2 and 6-9 stand rejected under 35 U.S.C. 102(b) “as being anticipated by Tsutsumi et al (5223311), as set forth in the previous rejection.” In support of the rejection, the Patent Office states the following:

Applicant argues that Tsutsumi does not teach a protective hood for automobiles. Applicant contends that Tsutsumi only teaches the laminate to be used as wrapping or packaging material for foods and dismisses Tsutsumi’s teaching to use the laminate in automotive applications as “a passing reference,” “vague, and open-ended.”

In response to this argument the examiner notes that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Here, it is the examiner’s position that the invention of Tsutsumi is capable of being used as a hood for an automobile. The examiner notes that not only does Tsutsumi teaches the exact same structure as applicant, but Tsutsumi also teaches, multiple times, that its invention can be used in the automotive field (col. 1, lines 17-18, col. 3, lines 11-14, col. 9, line 20, and col. 21, lines 42-44). The examiner further notes that

¹ In the outstanding Office Action, no mention is made of claims 10-12, which had been added in Applicant’s Amendment of June 5, 2003. It is believed that the lack of a reference to these claims was a clerical error and that these claims are, in fact, pending. If, for some reason, claims 10-12 are not pending, Applicant requests that the Patent Office please advise.

automobile hoods often comprise metal and Tsutsumi teaches the incorporation of a metal substrate (col. 21, lines 19-20).

Applicant argues that a protective hood must have a “shape or form” that permits it to serve its purpose of protective an automobile. The examiner notes that Tsutsumi’s laminate has the same shape and form as applicant’s laminate, i.e., sheet form.

Applicant argues that Tsutsumi fails to teach a butyl acrylate content of 17% because Tsutsumi only teaches a broad range encompassing 17%. The examiner notes that Tsutsumi’s limited range is interpreted as a teaching that Tsutsumi discloses every percentage point within that range. Applicant bears the burden of presenting a showing that 17% represents an unexpected result such that Tsutsumi did not possess the claimed limitation.

Said rejection is maintained from the last action.

Applicant respectfully traverses the foregoing rejection. Claim 1, from which claims 2 and 6-8 depend, has been amended herein and now recites “[p]rotective hood for automobiles comprising a composite material with a support material of nonwoven polypropylene and a coating material of a thermoplastic copolymer, wherein said coating material consists essentially of an ethylene-butyl acrylate copolymer and wherein said coating material is introduced onto the support material by means of extrusion coating.”

Thus amended, claim 1 is neither anticipated by nor rendered obvious over Tsutsumi et al. for at least the reason that Tsutsumi et al. does not teach or suggest a protective hood for automobiles that comprises, among other things, a coating material consisting essentially of an ethylene-butyl acrylate polymer.

Instead, Tsutsumi et al. discloses a coating material, i.e., a thermoplastic resin composition, that comprises (1) 10 to 95%, by weight, of an ethylene copolymer composed mainly of units derived from ethylene and units derived from an unsaturated carboxylic acid anhydride and (2) 70 to 5%, by

weight, of a flexible resin having an MFR (190°C) of 0.1 to 1.000 g/10 min. Accordingly, it can be seen that the coating material of Tsutsumi et al. differs from the coating material of claim 1 in that (i) the coating material of claim 1 does not include an ethylene copolymer derived, in part, from units of an **unsaturated carboxylic acid anhydride** and (ii) the coating material of claim 1 does not include a **mixture** of said ethylene copolymer **and** a flexible resin.

Claim 1 is further patentable over Tsutsumi et al. for the reason that Tsutsumi et al. does not teach or suggest a protective hood for automobiles. The Patent Office contends that the Tsutsumi laminate is suitable for making a protective hood and that, therefore, the limitation in question is met. Applicant respectfully disagrees. As noted in Applicant's Amendment of June 5, 2003, a protective hood for automobiles must have a particular shape or form to serve its intended purpose. The Tsutsumi laminate, which is merely a sheet, does not have the required shape and would have to be **modified** before it could be capable of performing the claimed function. The issue is not whether or not the Tsutsumi laminate could be used **to make** a protective hood for automobiles, but rather, whether or not such a laminate sheet, **without any modification thereto**, could be used as a protective hood for automobiles. Applicant respectfully submits that the Tsutsumi laminate could not be used as a protective hood for automobiles without first being modified.

Claim 2 is further patentable over Tsutsumi et al. for the reason that Tsutsumi et al. does not teach or suggest a butyl acrylate content of 17%. The Patent Office is apparently contending that claim 2 is **anticipated** by Tsutsumi et al. based on statements therein that a list of esters including butyl acrylate "may be selected as the third ingredient" in the ethylene copolymer and that "[t]he content of units derived from such third ingredient monomer(s) in the resulting polymer is not higher than 40% by weight." Applicant respectfully disagrees with the Patent Office's assertion that

Tsutsumi's disclosure that the content of the third ingredient is "not higher than 40% by weight" somehow serves as an anticipation of "every percentage point within that range." In order for a range to **anticipate** a species within the range, the species must be clearly envisaged from the range. Given the breadth of a 0-40% range, Applicant respectfully submits that 17% is not clearly envisaged therefrom. Moreover, given the breadth of the 0-40% range and the complete lack of guidance in Tsutsumi et al. that would lead one of ordinary skill in the art to arrive at 17%, it cannot be said that Tsutsumi et al. renders obvious 17%. Therefore, the Patent Office has not made its *prima facie* case, and Applicant need not demonstrate unexpected results.

Claim 9 is patentable over Tsutsumi et al. for at least the same types of reasons discussed above in connection with claim 1.

Accordingly, for at least the above reasons, the foregoing rejection should be withdrawn.

Claims 3-5 stand rejected under 35 U.S.C. 103(a) "as being unpatentable over Tsutsumi et al (5223311), as set forth in the previous rejection." In support of the rejection, the Patent Office states the following:

Applicant challenges the examiner's assertion that it is common and well known to thermally bond fabrics. In response the examiner directs applicant to the Handbook of Technical Textiles (pages 143-144), Ryan et al (6506873B1), Jones et al (6046118), McCormack et al (5964742), and Andrusko (5182162).

Applicant argues that the desire to render the laminate suitable for a variety of end use applications is too vague a motivation to alter the basis weight of the fabric and the amount of coating. However, it is the examiner's position that this motivation is a significant factor in commercial applications. For example, reducing the basis weight and amount of coating would allow the material to be used in food wrapping or small packaging. Whereas, increasing the basis weight and amount of coating would provide the material with improved utility to package a substance requiring additional cushioning or

protection as well as automotive applications. Therefore, simple modifications of these two properties vastly increases the commercial viability of the laminate material.

Said rejection is maintained from the last action.

Applicant respectfully traverses the foregoing rejection. Claims 3-5 depend from claim 1. Claim 1 is patentable over Tsutsumi et al. for at least the reasons given above. Therefore, based at least on their respective dependencies from claim 1, claims 3-5 are patentable over Tsutsumi et al.

Accordingly, for at least the above reasons, the foregoing rejection should be withdrawn.

In conclusion, it is respectfully submitted that the present application is now in condition for allowance. Prompt and favorable action is earnestly solicited.

If there are any fees due in connection with the filing of this paper that are not accounted for, the Examiner is authorized to charge the fees to our Deposit Account No. 11-1755. If a fee is

required for an extension of time under 37 C.F.R. 1.136 that is not accounted for already, such an extension of time is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on December 2, 2003

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